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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,936	02/23/2004	Shinya Suzuki	016886-0193	7685
22428	7590	06/07/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BUI, BING Q	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,936

Applicant(s)

SUZUKI ET AL.

Examiner

Bing Q. Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/04 & 6/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-5 are pending in the application for examination, wherein claims 1, 4 and 5 being independent.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in US on 2/23/04. It is noted, however, that applicant has not filed a certified copy of the JAPAN 10-272271 and JAPAN 11-240524 application as required by 35 U.S.C. 119(b).

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Katagawa (US Pat No. 5,010,569) cited in Applicant's IDS.

Regarding claim 1, referring to figures 1 and 2(a)-(b), Katagawa teaches a DTMF data generating apparatus which is used in a communication system code-compressing and transmitting a voice signal to an opposite-side communication apparatus and which generates DTMF data for reporting a DTMF signal being intermingled with said voice

signal to said opposite-side communication apparatus, said DTMF data generating apparatus comprising:

a DTMF code information generating unit for detecting the DTMF code of a DTMF signal to be reported to said opposite-side communication apparatus and generating DTMF code information on the basis of this result of detection (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43),

a time information generating unit for detecting the output duration time of said DTMF signal to be reported to said opposite-side communication apparatus and generating time information on the basis of this result of detection (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43), and

a DTMF data generating unit for generating DTMF data including the destination information of said opposite-side communication apparatus, said DTMF code information generated by said DTMF code information generating unit and said time information generated by said time information generating unit (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43).

Regarding claim 2, referring to figures 1 and 2(a)-(b), Katagawa teaches the DTMF data generating apparatus according to claim 1, wherein said DTMF data have a destination information storing area for storing said destination information and a DTMF content information storing area for storing said DTMF code information and said time information (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43).

Regarding claim 3, for processing a communication between a caller and a called destination via an ATM or broadband network, it is inherent to convert a dialed tone (DTMF) made by the caller to a form suitable for presentation to the ATM switch.

Regarding claim 4, referring to figures 1 and 2(a)-(b), Katagawa teaches a DTMF data generating method which is used in a communication system transmitting a voice signal to an opposite-side communication apparatus and generates DTMF data for reporting a DTMF signal being intermingled with said voice signal to said opposite-side communication apparatus, said method comprising the steps of:

detecting the DTMF code of a DTMF signal to be reported to said opposite-side communication apparatus and generating DTMF code information on the basis of this result of detection (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43),

detecting an output duration time of said DTMF signal to be reported to said opposite-side communication apparatus and generating time information on the basis of this result of detection (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43), and

generating DTMF data including the destination information of said opposite-side communication apparatus, said DTMF code information and said time information (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43).

Regarding claim 5, referring to figures 1 and 2(a)-(b), Katagawa teaches a DTMF data structure for being used in a communication system code-compressing and transmitting a voice signal to an opposite side communication apparatus and for reporting a DTMF signal being intermingled with said voice signal to said opposite-side communication apparatus, said structure comprising:

a destination information storing area for storing destination information indicating the destination of said opposite-side communication apparatus to be notified of said DTMF signal (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43), and  
a DTMF content information storing area for storing DTMF code information indicating the code of a DTMF signal to be reported to said opposite-side communication apparatus and time information indicating the output duration time of a DTMF signal to be reported to said opposite-side communication apparatus (see figures 1 and 2(a)-(b); and col. 5, ln 3-col. 7, ln 43).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art in general:

U.S. Pat. No. 6,023,474

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (571) 272-7482. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 and for formal communications intended for entry (please label the response

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☐EXPEDITED PROCEDURE☐) or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

24 May 2005

A handwritten signature in black ink, appearing to read 'Bing Q. Bui', written in a cursive style.

**BING Q. BUI**  
**PRIMARY EXAMINER**